

REMARKS

The Office Action of March 8, 2006 was received and reviewed. Applicant would like to thank the Examiner for the consideration given to the above-identified application. Particularly, the Examiner is thanked for his thorough review of the application and his comments regarding the 35 U.S.C. §112, 1st paragraph rejection.

Reconsideration and withdrawal of the currently pending rejections are requested for the reasons advanced in detail below.

Claims 1-36 were pending for consideration. By this Amendment, claims 1-4, 7-10, 13-16, 19-22, 25-28 and 31-34 have been amended, and claims 5, 11, 17, 23, 29 and 35 have been canceled. Accordingly, claims 1-4, 6-10, 12-16, 18-22, 24-28, 30-34 and 36 are pending, of which claims 1, 7, 13, 19, 25 and 31 are independent.

Referring now to the detailed Office Action, claims 1-36 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-27 of U.S. Patent No. 6,706,568 (hereafter the '568 patent). In response, Applicant respectfully notes that the claims of the '568 patent do not recite "a wavelength of the third laser beam is different from that of the first laser beam". Therefore, the Examiner's assertion that claim 1 of the '568 patent recites all of the steps of claim 1 of the instant application is clearly insupportable. Further, by the claim amendments above, Applicant respectfully requests that this double patenting rejection be held in abeyance until the claims are in condition for allowance, if the Examiner continues to maintain this rejection.

Claims 1-36 stand rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. The Examiner asserted that independent claims 1, 7, 13, 19, 25 and 31 fail to recite the step of "forming an oxide film on a surface of the above semiconductor film" and therefore the claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In response, Applicant have amended all independent claims, as shown above, to further recite forming an oxide film. Consequently, in view of the amended independent claims, dependent claims 5, 11, 17, 23, 29 and 35 have been canceled.

Claims 7-12 stand rejectable if claims 13-18 are found allowable. The Examiner asserted that claims 13-18 will be objected to under 37 C.F.R. 1.75 as being a substantial

duplicate of claims 7-12. In response, Applicant submits that claims 7 and 13, for example, recite different features. For example, claim 7 recites “radiating the semiconductor film with a second laser beam after radiating with the first laser beam under an atmosphere comprising one of hydrogen and an inert gas”, while claim 13 recites “radiating the semiconductor film with a third laser beam after radiating with the second laser beam under an atmosphere comprising one of hydrogen and an inert gas”. Applicant respectfully submits that the above-mentioned exemplary features of claims 7 and 13 are clearly different. As claims 7-12 differentiate from claims 13-18, the claims are not duplicate of one another as alleged by the Examiner.

Claims 1 and 5 stand rejected under 35 U.S.C. §102(e) as being anticipated by Nita et al. (U.S. Patent No. 6,304,329 – hereafter Nita). Further, claims 2, 3, 7-9, 11, 13-15, 17, 25-28 and 31-33 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Nitta and further in view of Mitnaga et al. (U.S. Patent No. 5,808,321 – hereafter Mitnaga). Still further, claims 4, 6, 10, 12, 16, 18-24, 29-30 and 34-36 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Nitta and in view of Mitnaga and further in view of Ouderkirk et al. (U.S. Patent No. 4,879,176 – hereafter Ouderkirk). These rejections are respectfully traversed at least for the reasons provided below.

Initially, these rejections summarized above are a repeat of the rejections found in the Office Action mailed August 25, 2005. Hence, Applicant’s previous arguments are again submitted herein. Applicant notes, however, that dependent claims 3-4, 8-10, 14-16, 20-22, 26-28 and 32-34 have been amended as shown above, so as to improve the clarity of the claim language by the use of active voice in the amended claims. The amendment to claims 3-4, 8-10, 14-16, 20-22, 26-28 and 32-34 renders the Examiner’s assertion that functional language is not given patentable weight and that the limitations following the “wherein” clauses in the claims are not given patentable weight because of the language is in narrative form as moot.

With respect to the rejection of claims 5, 11, 17, 23, 29 and 35, the cancellation of these claims renders their rejections as moot.

With respect to the rejection under 35 U.S.C. 102(e) and 103(a), as previously submitted, Applicant notes that Nita is commonly cited in all of the substantive rejections. In the rejections, the Examiner alleged that 52, 53 and 54 of Nitta are laser beams irradiating

a semiconductor film. However, Applicant respectfully notes that features 52, 53 and 54 (such as shown in Fig. 12) of Nitta are laser diodes that are provided in order to detect the angular velocity off the other object, and the laser diodes are utilized in a ring resonator in a gyro. Therefore, Nitta does not disclose radiating the semiconductor film with laser beams as recited in Applicant's claimed invention, which is directed to a method of manufacturing a semiconductor device wherein a semiconductor film is crystallized by laser radiation. Moreover, as Nitta is related to a gyro having a plurality of laser diodes, and although Nitta teaches how the laser diodes are made, Nitta does not teach, disclose or suggest, for example, the steps of forming a semiconductor film over an insulating surface, radiating the semiconductor film with a first laser beam, forming an oxide film, etc, as recited in Applicant's amended claim 1.

Consequently, since each and every feature of the present claims is not taught (and is not inherent) in the teachings of Nitta, as is required by MPEP Chapter 2131 in order to establish anticipation, the rejection of claim 1, under 35 U.S.C. §102(e), as anticipated by Nitta is improper.

With respect to the §103(a) rejection of claims 2, 3, 7-9, 11, 13-15, 17, 25-28 and 31-33, independent claims 7, 13, 19, 25 and 31 have also been amended, as shown above, to further recite forming an oxide film. The arguments set forth above with respect to claim 1 are also applicable.

With respect to the rejection of claims 4, 6, 10, 12, 16, 18-24, 29-30 and 34-36 over Nitta, Mitnaga and Ouderkirk, the arguments set forth above with respect to Nitta and the §102(e) rejection are also applicable.

Further, although the Examiner contended that Applicant negates obviousness by piece meal analysis of the applied references and ignored the combined teachings of the references, Applicant respectfully submit that the rejections themselves rely on piece meal applications of various features from various reference without proper motivation or suggestion to combine.

Further, Applicant acknowledges appreciation the fact that the Examiner for his great efforts and thoughts into pointing out the claimed invention must recite the step of forming an oxide film. However, in combining the cited references, proper motivation and suggestion for combining, how to modify different teachings of the cited references, and a reasonable

expectation of success in combining the different inventions disclosed by the cited prior art references have not been demonstrated, and a *prima facie* case of obviousness has not been properly established.

The requirements for establishing a *prima facie* case of obviousness, as detailed in MPEP § 2143 - 2143.03 (pages 2100-122 - 2100-136), are: first, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference to combine the teachings; second, there must be a reasonable expectation of success; and, finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations.

As all the pending independent claims have been amended, as shown above, and as Nitta, Mitnaga and Ouderkirk are deficient as noted above, their combination in the §103(a) rejections is improper and a *prima facie* case of obviousness has not been established.

In view of the foregoing, it is respectfully requested that the rejections and warning of record be reconsidered and withdrawn by the Examiner, that claims 1-36 be allowed and that the application be passed to issue. If a conference would expedite prosecution of the instant application, the Examiner is hereby invited to telephone the undersigned to arrange such a conference.

Respectfully submitted,



Luan C. Do
Registration No. 35,483

NIXON PEABODY LLP
Suite 900, 401 9th Street, N.W.
Washington, D.C. 20004-2128
(202) 585-8000